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Eleanor S. Wilson

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3693

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/681,412

Applicant(s)

WILSON ET AL.

Examiner

Ella Colbert

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 and 45-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 45-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-63 are pending. Group I, Claims 1-20 and 45-53 have been elected for prosecution with traverse in the response to the Election/Restriction Requirement filed 3/27/06. The Response to Arguments will be addressed in the "Response To Arguments with Traverse" section of this Office Action.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 11-17, 45-48 rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,148,293) King.

Claims 1, 11, and 45. King discloses, A method for operating a computer to facilitate a choice of a financing product, said method comprising the steps of: prompting a customer to provide information related to a financing requirement (col. 13, lines 37-44); determining a proper financing product based upon provided information (col. 13, lines 45-67); and prompting the customer with a recommendation for a financing product (col. 14, lines 1-65).

Claim 11. King further discloses A computer programmed to: determine a proper financing product for the customer (col. 14, lines 50-65); and prompt the customer with an inquiry as to whether they wish to pursue financing opportunities (col. 15, lines 37-

52). King did not expressly disclose a computer program. However, a computer is known in the computer art to have a program (a set of instructions when executed tells the computer what to do). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in King a computer programmed to perform the functions of claim 11 because such a modification would allow King to have the capability of the computer having a set of instruction to execute.

Claim 45. King further discloses Apparatus comprising:  
means for prompting a customer to select a financing type (col. 7, lines 28-35).

Claims 11 and 45 are rejected for the similar rationale as given above for claim 1.

Claims 2, 12, and 46. King discloses, further comprising the step of displaying a computer generated screen listing a plurality of financing type selections (col. 13, lines 58 and 59, fig. 6b, and col. 15, lines 53-57).

Claims 3, 13, and 47. King discloses, wherein said financing type selections comprise at least one of project finance, high yield debt, leasing, project common equity, limited partnership, private equity and preferred equity (col. 1, lines 39-49, col. 2, lines 4-17, and col. 7, lines 28-44).

Claims 4, 14, and 48, King failed to disclose, a project common equity financing type selection, prompting the customer to provide information comprises the step of displaying a computer generated screen prompting the customer to enter criteria to value the equity in their property. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify King to have a project common equity financing type selection, prompt the customer to provide information

comprising the step of displaying a computer generated screen prompting the customer to enter criteria to value the equity in their property because such a modification would allow King to give the age of the property, the location of the property, the condition of the property and the purchase price of the property in order to be provided a loan to purchase the property and to use the property as collateral for the loan.

Claims 5 and 15. King discloses, wherein the property is a power generation plant, the criteria requested being at least one of power plant information, current financing information, projected electricity prices and projected fuel costs (col. 7, lines 9-27 and col. 8, line 48-col. 9, line 41). A power plant is a design choice. The current financing information can be current financing for anything. For example, a loan for a car or a home or a warehouse or a commercial property.

Claims 6, 16, and 50. King failed to disclose, wherein default values are available for at least one of projected electricity prices and projected fuel costs, when specific values are not provided. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in king because such a modification would allow King to have set default values when an estimate is being made and the specific costs are not known or accessible.

Claims 7 and 17. King discloses, further comprising the step of displaying a computer generated screen describing a selected financing type (col. 13, lines 16-36).

4. Claims 8-10, 18-20, 51-53 rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,148,293) King in view of (US 2002/0143680 A1) Walters et al.

Claims 8, 18, and 51. King failed to disclose, wherein prompting the customer to provide information comprises the steps of: displaying a computer generated screen listing a plurality of background questions relating to the financing requirement; and displaying a computer generated screen listing a plurality of financing specific questions. Walters discloses, wherein prompting the customer to provide information comprises the steps of: displaying a computer generated screen listing a plurality of background questions relating to the financing requirement; and displaying a computer generated screen listing a plurality of financing specific questions (page 1, col. 2 [0010] –page 2, col. 1 [0017])

Claims 9, 19, and 52. King failed to disclose, wherein the background questions relating to the financing requirement comprise at least one of the country where financing is required, which energy related business is the financing for, is the financing required for an operating asset, are U.S. taxes currently being paid by the customer, is the customer interested in either of off-balance sheet or non-recourse financing, and is the customer interested in structured debt such as high yield debt or subordinated debt. Walters discloses, wherein the background questions relating to the financing requirement comprise at least one of the country where financing is required, which energy related business is the financing for, is the financing required for an operating asset, are U.S. taxes currently being paid by the customer, is the customer interested in either of off-balance sheet or non-recourse financing, and is the customer interested in structured debt such as high yield debt or subordinated debt (page 2, col. 2 [0020]-[0025] and page 3, col. 2 [0047]-page 4, col. 1, line 33).

Claims 10, 20, 53. King failed to disclose, wherein the financing specific questions comprise at least one of amount of financing, selling or optimizing equity position, willing to share control, upside potential and residuals of the asset, willing to subordinate equity distribution to a preferred equity investor, willing to be contacted regarding the financing, early stage pre-lpo company or company in early stage of corporate cycle and interested in financing senior to common equity but junior to lenders and trade creditors. Walters discloses, wherein the financing specific questions comprise at least one of amount of financing, selling or optimizing equity position, willing to share control, upside potential and residuals of the asset, willing to subordinate equity distribution to a preferred equity investor, willing to be contacted regarding the financing, early stage pre-lpo company or company in early stage of corporate cycle and interested in financing senior to common equity but junior to lenders and regarding the financing, early stage pre-lpo company or company in early stage of corporate cycle and interested in financing senior to common equity but junior to lenders and trade creditors.

Claim 49. King failed to disclose, Apparatus according to Claim 48 wherein information for valuation of a facility comprises at least one of the plant size, a heat rate, a percentage of revenues under contract, a number of years remaining under contract, a remaining term of the existing debt, an outstanding principal, interest rate, electricity prices and an annual rate of increase, and projections of prices and projected fuel costs including an escalator. Walters discloses, wherein information for valuation of a facility comprises at least one of the plant size, a heat rate, a percentage of revenues under

contract, a number of years remaining under contract, a remaining term of the existing debt, an outstanding principal, interest rate, electricity prices and an annual rate of increase, and projections of prices and projected fuel costs including an escalator (page 1, col. 1 [0003]).

### **Response to Arguments with Traverse**

5. Applicants' election with traverse of Group I, claims 1-20 and 45-53 in the communication of 3/27/06 is acknowledged. The traversal is on the ground(s) that a thorough search and examination of any group would not be a serious burden on the Examiner. The Office action suggests that "the inventions require a different field of search" and the Applicants' respectfully disagree and submit that a search of the subject matter of any Group I, II, III, IV, and/or V would also include the subject matter of the claims of the other groups.

Further, the Office action has not shown the claims of Groups I, II, III, IV and V are patentably distinct in accordance with MPEP 806.05 (e). Particularly, the Office action has not shown that the apparatus as claimed not the process as claimed can be used to practice another and materially different process or materially different apparatus by hand.

These arguments are not found persuasive because in this case Group I can be used to perform the method for facilitating a choice of a financing product in any Internet environment and Group II the database can be used to store the information related to a financing requirement in any environment where financing is required. For example, a loan for a house or a car, etc. Group III can be used for initiating the financing



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transaction and the system of Group IV can be used for facilitating the financing transactions for one or more investments in a utility plant or a manufacturing plant. Group V can be used for keeping a customer record and calculating the equity in a facility such as a utility plant or manufacturing plant or any other similar facility.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim 21 has a database with data corresponding to answers to questions about a customer's financing requirement and a recommended financing type and claim 21 has the selection of a financing type, the entry of contact information and information concerning the financing transaction, and a request for further contact concerning financing, claim 42 enters the answers to background questions and answers to specific financing questions concerning a financing requirement and requesting a financing type

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recommendation, and claim 54 has a database with data corresponding to available transactions for power generation plants and prompting a customer to answer questions concerning power generation plants. Where are these claim limitations found in independent claims 1, 11, and 45?

The requirement is still deemed proper and is therefore made FINAL.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Spira et al (US 2002/0035495 A1) disclosed assessment of services for a plant.

### ***Inquiries***


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Trammell James can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 10, 2006



ELLA COLBERT  
PRIMARY EXAMINER